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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,150	11/02/2001	Shell Sterling Simpson	10008212-1	7884

7590

02/09/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,150

Applicant(s)

SIMPSON ET AL.

Examiner

Mark Fadok

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11-13 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-13 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 8/25/2005, which was received 11/18/2005. Acknowledgement is made to the cancellation of claims 5 and 6 and the addition of claim 30, leaving claims 1-4, 11-13 and 30 as pending in the instant application. Applicant's amendment and arguments have been carefully considered but were not found to be persuasive; therefore the following rejection modified as necessitated by amendment follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 11, 13 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Garfinkle (US 6,924,878).

In regards to claim 1, Garfinkle discloses a method for facilitating pay printing (abstract), the method comprising:

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a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network (col 6, lines 1-25) ;

the printing service receiving print option selections (col 6, lines 1-25); and
the printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version (col 9, lines 53-65).

In regards to claim 2, Garfinkle teaches wherein the at least one store comprises a graphic store and a composition store (FIG 1).

In regards to claim 3, Garfinkle teaches wherein the at least one store is associated with an imaging source with which the full-sized document is created or identified (col 9, lines 22-50)).

In regards to claim 4, Garfinkle teaches wherein the imaging source comprises a network-based imaging service (FIG 1).

In regards to claim 7, Garfinkle teaches wherein the scaled down version comprises one or more thumbnails that represent document pages (see response to claim 6).

In regards to claim 11, Garfinkle teaches wherein receiving print option selections comprises receiving user selections with a web site of the network-based printing service (FIG 5D).

In regards to claim 13, Garfinkle teaches wherein the determination of the printing costs is dependent upon attributes of the scaled-down version and the option selections (FIG 5D).

In regards to claim 30, Garfinkle teaches wherein the scaled-down version is created by a network-based imaging service with which the full-sized document was created or identified (FIG 3B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle in view of Official Notice.

In regards to claim 12, teaches a pay-for-print service that is supported by servers, but does not specifically mention that the service is supported by a

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printing device having an embedded server. It was old and well known in the art at the time of the invention to provide printing devices with embedded servers. It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide printing devices with embedded servers, because these devices would be acting as a vending machine for distributing the product and could therefore do some of the processing locally rather than having to be in communication with a remote server thus removing potential bandwidth issues.

Response to Arguments

Applicant's arguments filed 11/18/2005 have been fully considered but they are not persuasive.

Applicant argues that Garfinkle does not teach a net-worked based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network". The examiner disagrees and notes that Garfinkle teaches the retrieval of thumbnail images and digital data representing full –scale pictures, which are smaller than the full sized pictures being ordered. Also please note that after reviewing the specification the examiner has concluded that the system represented in FIG 1 of Garfinkle could represent the "printing service " of the instant invention.

Applicant argues that Garfinkle does not teach "a printing service determining printing costs for printing the full-sized document based upon attributes of the scaled-down version". The examiner disagrees and directs the applicant's attention to col 6, lines 1-20 (also adobe PhotoShop), where Garfinkle

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clearly teaches defining attributes to be associated with the costing by the fulfillment center (col 9, lines 25-65).

Applicant argues the examiner's use of official notice and asks that a reference be provided. To satisfy the applicant's request LeClair et al is provided (see at least col 5, lines 1-3).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose

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telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(571) 273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

(571) 273-6755 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]



Mark Fadok

Primary Examiner